

REMARKS:

Claims 1-29 are currently pending in the application.

Claims 3, 11, and 20 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. ("*Haji*") in view of U.S. Patent No. 6,105,004 to Halperin et al. ("*Halperin*").

Although the Applicant believes Claims 1-29 are directed to patentable subject matter without amendment, the Applicant has amended Claims 2, 11, and 20 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In addition, the Applicant respectfully submits that the amendments to Claims 2, 11, and 20 are not necessitated by any prior art and are unrelated to the patentability of the subject Application. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 112:

Claims 3, 11, and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Applicant respectfully disagrees.

The Examiner specifically states that "as to Claims 3, 11, and 20, the phrase 'substantially prevent' is indefinite." The Applicant respectfully disagrees. In addition, the Applicant initially notes that Claim 3 does not contain the phrase "substantially prevent" as stated by the Examiner. However, Claim 2 along with Claims 11 and 20 do, in fact,

contain the phrase “substantially prevent”. Therefore, in order to expedite prosecution of this Application, the Applicant is treating the rejection of Claims 3, 11, and 20 under 35 U.S.C. § 112, second paragraph, to be a typographical error and instead the rejection of Claims 3, 11, and 20, is being treated as a rejection of Claims 2, 11, and 20, since Claims 2, 11, and 20 do in fact contain the phrase “substantially prevent”, as asserted by the Examiner.

In light of the above discussion, the Applicant has amended Claims 2, 11, and 20 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner’s position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action. In addition, the Applicant respectfully submits that the amendments to Claims 2, 11, and 20 are not necessitated by any prior art and are unrelated to the patentability of the subject Application.

The Applicant respectfully submits that Claims 2, 11, and 20 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicant further respectfully submits that Claims 2, 11, and 20 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 2, 11, and 20 under 35 U.S.C. § 112 be reconsidered and that Claims 2, 11, and 20 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. (“*Haji*”) in view of U.S. Patent No. 6,105,004 to Halperin et al. (“*Halperin*”).

The Applicant respectfully submits that *Haji* or *Halperin*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 1-29. Thus, the Applicant respectfully traverses the Examiner’s obvious rejection of Claims 1-29

under 35 U.S.C. § 103(a) over the proposed combination of *Haji* or *Halperin*, either individually or in combination.

The Proposed *Haji-Halperin* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to independent Claim 1, this claim recites:

A **system** comprising one or more computers associated with a buyer **for locally generating price quotes**, the one or more computers **associated with the buyer** collectively operable to:

receive a pricing tool from a seller, the pricing tool operable to generate price quotes for the seller;

locally store the pricing tool received from the seller such that the pricing tool is locally accessible to the one or more computers associated with the buyer;

access a request for quote (RFQ) specifying an order comprising quantities of one or more items, the RFQ requesting a price quote for the order;

communicate the RFQ to the locally accessible pricing tool;

using the locally accessible pricing tool received from the seller, locally generate a price quote for the order; and

provide the locally generated price quote for the order for possible further action by the buyer. (Emphasis Added).

Independent Claims 10, 19, 28, and 29 recite similar limitations. *Haji* or *Halperin*, either individually or in combination, fail to disclose each and every limitation of independent Claims 1, 10, 19, 28, and 29.

The Applicant respectfully submits that *Haji* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “**system** comprising one or more computers associated with a buyer **for locally generating price quotes**, the one or more computers **associated with the buyer**” and in particular *Haji* fails to disclose, teach, or suggest independent Claim 1 limitations regarding “**receive a pricing tool from a seller**, the pricing tool operable to generate price quotes for the seller”. In particular, the Examiner equates “**receiv[ing] a pricing tool from a seller**” recited in independent Claim 1 with the **system for receiving orders** disclosed in *Haji*. (4 January 2007 Office Action, Page 3).

However, ***the system for receiving orders disclosed in Haji*** is merely the ability for the a server in *Haji* to provide through a network a web page, and ***does not include, involve, or even relate to receiv[ing] a pricing tool from a seller***, as recited in independent Claim 1. (Paragraphs [0070-0075]). In contrast, ***“receiv[ing] a pricing tool from a seller”*** recited in independent claim 1 ***is provided for a pricing tool that is operable to generate price quotes for the seller***. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Haji* and independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent claim 1 from *Haji*.

The Office Action Acknowledges that *Haji* Fails to Disclose Various Limitations Recited in Applicant’s Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicants agree, that *Haji* fails to disclose the emphasized limitations noted above in independent claim 1. Specifically the Examiner acknowledges that *Haji* fails to teach “the specified order comprising ***quantities of one or more items***”. (4 January 2007 Office Action, Page 4). However, the Examiner asserts that the cited portions of *Halperin* disclose the acknowledged shortcomings in *Haji*. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Halperin*.

The Applicant respectfully submits that *Halperin* fails to disclose, teach, or suggest independent Claim 1 limitations regarding ***“access[ing] a request for quote (RFQ) specifying an order comprising quantities of one or more items***, the RFQ requesting a price quote for the order”. In particular, the Examiner equates ***“quantities of one or more items”*** recited in independent Claim 1 with the ***“purchase information”*** disclosed in *Halperin*. (4 January 2007 Office Action, Page 4). However, the ***“purchase information”*** disclosed in *Halperin* is merely displayed on a screen, but ***does not include, involve, or even relate to the quantities of one or more items***, as recited in independent Claim 1. (Column 4, Lines 1-4). In contrast, the ***“quantities of one or more items”*** recited in independent claim 1 ***is associated with a buyer for locally generating price quotes***

wherein a request for quote is accessed specifying an order which comprises quantities of one or more items. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Halperin* and independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent claim 1 from *Halperin*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Haji-Halperin* Combination

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Haji* or *Halperin*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the specified order in *Haji*'s teaching to include quantities of the ordered items as taught by *Halperin*”. (4 January 2007 Office Action, Page 4). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Haji* or *Halperin*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be “so that the buyer can have ***better idea*** of the total costs ***of the order that have multiple purchased items***”. (4 January 2007 Office Action, Page 4). (Emphasis Added). The Applicant respectfully disagrees. For example, how does “***hav[ing] a better idea***” allow the alleged specified order in *Haji*'s to include quantities of the ordered items as allegedly taught by *Halperin* and to what extent does the Examiner purport that “***hav[ing] a better idea***” applies to the subject Application. ***The Applicant respectfully requests the Examiner to point to the portions of Haji or Halperin which contain the teaching, suggestion, or motivation to combine these references for the Examiner's stated purported advantage.*** The Applicant respectfully submits that the

Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the **Examiner has not adequately supported the selection and combination of Haji and Halperin to render obvious the Applicant's claimed invention.** The Examiner's unsupported conclusory statements that "t would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the specified order in *Haji's* teaching to include quantities of the ordered items as taught by *Halperin*" and that "so that the buyer can have **better idea** of the total costs **of the order that have multiple purchased items**", **does not adequately address the issue of motivation to combine.** (4 January 2007 Office Action, Page 4). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of Haji and Halperin**, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed Haji-Halperin Combination

With respect to independent Claims 10, 19, 28, and 29 these claims includes limitations similar to those discussed above in connection with independent Claim 1. Thus, independent Claims 10, 19, 28, and 29 are considered patentably distinguishable over the proposed combination of *Haji* and *Halperin*, for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2-9, 11-18, and 20-27: Claims 2-9 depend from independent Claim 1; Claims 11-18 depend from independent Claim 10; and Claims 20-27 depend from independent Claim 19. As mentioned above, each of independent Claims 1, 10, 19, 28, and 29 are considered distinguishable over *Haji* and *Halperin*. Thus, dependent Claims 2-9, 11-18, and 20-27 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-29 are not rendered obvious by the proposed combination of *Haji* and *Halperin*. The Applicant further respectfully submits that Claims 1-29 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-29 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-29 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact,

the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

3 April 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1423 S. Higley Rd., Ste. 110
Mesa AZ, 85206
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184